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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,483	08/30/2001	Gary E. LeGrow	577-126	8082

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[REDACTED] EXAMINER

YU, GINA C

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1617  
DATE MAILED: 08/13/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/942,483	LEGROW, GARY E.
	Examiner	Art Unit
	Gina C. Yu	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 09 May 2003 .

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) 16-30 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> .	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Election/Restrictions***

Claims 16-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "PEG" in claims 9-12 is used by the claim to mean "polyoxylethylene," while the accepted meaning is "polyethylene glycol." See Hawley, The Condensed Chemical Dictionary, p. 662.

The term "substantially" in claim 13 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 4-8, 10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clariant technology disclosure (The Future of Silicones, Silcare 180 M and 1M) in view of Policello et al. (US 6221922 B1) ("Policello").

Clariant teaches that Silcare 1M71 stearoxytrimethylsilane forms stable clear microemulsions, and suitable for cosmetic formulations by simple mixing without heating, leaving a persistent, silky, non-greasy feeling on the skin. See p. 6. The reference also teaches retinoxytrimethylsilane. See p. 7; instant claim 8. The reference fails to teach using hydrophobic and hydrophilic organosilicone surfactants.

Policello teaches foam control agents for silicone surfactants. The "surfactant matrix" used in the invention comprises Silwet series silicone copolymers, which are hydrophilic, and silicone polyethers, which are hydrophobic. See col. 1, line 55 – col. 2, line 35. A silicone foam control agent is also used. See col. 1, lines 36 – 53. See instant claims 14 and 29. The reference generally teaches that a disadvantage of using alkoxyLATED organosilicon surfactants is difficulty of controlling foams generated from these products. The reference teaches the use of organosilicon surfactants such as tetra- or trisiloxane alkoxylates are known to reduce the aqueous surface tension of spray solutions. See col. 1, lines 9 – 16. Policello also teaches that silicone polyethers

are known as an emulsifier or a spreading agent for a defoamer. See col. 1, lines 17 – 29.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the silicone emulsions in Clariant by adding the foaming control agent mixture as motivated by Policello, because of the expectation of successfully reducing the aqueous surface tension and controlling foam.

2. Claims 1-3, 10, 13, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (US 6074470) ("Fisher") in view of Policello.

Fisher teaches a silicone-in-water emulsion composition comprising dispersion of alkoxysilane having particle size of preferably less than 0.5 micrometers. See col. 4, line 9 – col. 5, line 2. The reference teaches the suitable trialkoxysilanes in col. 4, lines 46 – 57. The reference teaches to use an ethoxylated, nonionic primary surfactant having a HLB greater than 13.0; and a nonionic cosurfactant having HLB of less than 13.0. See col. 6, line 36 – col. 7, line 25 for additional ingredients such as antifoaming agents and foaming agents. See instant claims 14 and 29.

Fisher fails to the organosiloxane surfactants recited in the instant claims.

Policello is discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the silicone emulsion in Fisher by adding the foaming controlling agent mixture as motivated by Policello because of the expectation of successfully producing a sprayable composition with reduced water surface tension and controlled foaming property.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clariant technology disclosure and Policello as applied to claims 1, 4-8, 10, and 14 above, and further in view of Aldous (US 5543136).

Clariant technology disclosure and Policello, discussed above fail to teach the surfactants of instant claim 9.

Aldous teaches a stable sunscreen emulsion comprising cetyl dimethicone copolymer (Abil Em-90 by Goldschmidt). See Example 1. See col. 3, lines 26 – 29.

Given the teaching of the applicability of stearoxytrimethylsilane in sunscreen compositions, one having ordinary skill in the art would have been motivated to look to the prior art such as Aldous for conventional sunscreen formulations which include cetyl dimethicone copolyol in expectation of successfully producing a stable sunscreen composition.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Art Unit: 1617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
August 11, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER  
8/11/03